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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/360,521	07/23/1999	SERGE RESTLE	05725.0446-0	4299

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EXAMINER

MITCHELL, GREGORY W

ART UNIT

PAPER NUMBER

1617

DATE MAILED: 02/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/360,521

Applicant(s)

RESTLE ET AL.

Examiner

Gregory W Mitchell

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-47 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-47 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>10/27/04</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This Office Action is in response to the remarks filed on October 27, 2004. No claims have been added or amended. Claims 1-47 are pending and are examined herein.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 27, 2004 has been entered.

Claim Rejections - 35 USC § 103

Claims 1-32, 34-41 and 43-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Decoster (WO 97/46210, using USPN 6451747 as an English language equivalent) ('747) in view of Decoster (WO 97/46211, English translation) ('211).

The instant invention is directed toward a composition comprising a washing base comprising an anionic and amphoteric surfactant, wherein the ratio of amphoteric:anionic is greater than or equal to 0.1:1, and a conditioner system

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comprising at least one aminated silicon having an amine number greater than or equal to 0.4 meq/g, and a cationic polymer.

'747 teaches detergent and conditioning hair care compositions comprising, in a cosmetically acceptable medium, a washing base and a conditioning system comprising at least one cationic polymer and a mixture of at least one amine silicone and a grafted silicone polymer. Exemplified is a composition comprising 14 g of lauryl ethersulfate of sodium (anionic surfactant, 14% of composition), 3.2 g cocoyl betaine (amphoteric surfactant, 3.2%), 1.05 g amino silicone, 0.1 g guar gum modified by chloride of 2,3-epoxypropyl trimethylammonium (cationic polymer, 0.1%), and water, wherein the ratio of amphoteric/anionic surfactant is 0.23. For cellulose derivatives containing quaternary ammonium groups, see col. 6, lines 27-35. For cationic polysaccharides, see col. 6, lines 49-56. For quaternary diamonium polymers comprising 0.001-10% of the composition, see col. 11, lines 1-5. For compounds of formula (I), formula (IV), and formula (II), and limitation of claims 13-25 and 27-29, see col. 17, line 4-col. 19, line 16. For aminosilicones comprising 0.05-10% of the composition, see col. 19, lines 17-21. For water or an aqueous alcoholic solution as the vehicle, see col. 19, lines 22-24. For ethanol, isopropanol, and butanol, see col. 19, lines 24-25. For fragrances, preservatives, sequestering agents, thickeners, softeners, foam modifiers, dyes, and other adjuvants, see col. 19, lines 36-42. For a process of washing and conditioning keratin fibers, such as hair, see col. 19, lines 62-67. The reference lacks an exemplification of the preferred aminated silicones, the preferred amount of solvent, and a teaching of transparency.

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'211 exemplifies a shampoo composition comprising 14 g laurylethersulfate of sodium (anionic surfactant, 14% of composition), 1 g laurylsulfate of ammonium (anionic surfactant, 1%), 4.6 g cocoamidoethyl (N-hydroxyethyl, N-carboxymethyl) glycinate of sodium (amphoteric surfactant, 4.6%), 2.5 g amine silicone with an amine index of 0.5 meq/g (2.5%), 0.1 g guar gum modified by chloride of 2,3-epoxypropyl trimethylammonium (cationic polymer, 0.1%), and water, wherein the ratio of amphoteric/anionic surfactant is 0.3:1. For the washing base comprising 4-50% of the composition, see pg. 6, last paragraph. For perfumes, preservatives, sequestering agents, thickeners, softeners, foam modifiers, coloring agents, moisturizers, anti-dandruff/antiseborrheic agents, vitamins, sun filters, and suspension agents, see pg. 28, 3rd paragraph. For derivatives of cellulose ethers that include quaternary ammonium groups and cationic polysaccharides, see pg. 16 (2) and (4). For cationic polymers of formula (a) of instant claim 35, see pg. 20 (10). For cationic polymers comprising 0.001-10%, see pg. 27, 1st paragraph. For ethanol, isopropanol, and butanol, see pg. 28, 1st paragraph. For a process of washing and conditioning keratinic fibers, such as hair, see pg. 29, 3rd paragraph.

It would have been obvious to one of ordinary skill in the art at the time of the invention to substitute the amodimethicone exemplified in '747 for the compounds of Formulas (I), (IV) or (II) of the instant invention because the precise formulas of these compounds are specifically taught by '747 to be aminosilicones useful in the invention taught therein. It is noted that '747 specifically teaches the exact same formulas as instantly claimed. It is specifically pointed out that the repeat unit variables (m and n)

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are taught in both '747 and in the instant invention to be chosen such that the sum of $(n+m)$ is between 1 and 2000. It is also pointed out that n and m are both taught by '747 to be between 1-1999 and 1-2000, respectively.

It would have been obvious to one of ordinary skill in the art at the time of the invention to exemplify an amodimethicone of Formulas (I), (IV) or (II) of the instant invention with an meq/g of 0.5 because (1) both '747 and '211 teach detergent cosmetic compositions for hair care; (2) both '747 and '211 teach a composition comprising a washing base and a conditioning system wherein the conditioning system comprises at least one cationic polymer and an aminosilicone; and (3) '211 teaches that the aminosilicone should be formulated such that the meq/g is 0.5. One would have been motivated to formulate the aminosilicone to have an meq/g of 0.5 because of an expectation of success in preparing a detergent cosmetic composition, as taught by '747.

It would have been obvious to one of ordinary skill in the art at the time of the invention to teach the solvents of '747 as comprising 0.1-20% of the composition because '747 teaches the use of vehicles in general and where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955). It is noted that '747 teaches the compositions of the invention disclosed therein may be formulated in a variety of manners, e.g. as liquids more or less thickened, as creams and as gels. Accordingly, it is suggested by '747 that the amount of vehicle used in the formulation of the compositions taught therein is variable and that

it would have been obvious to one of ordinary skill in the art to vary the amount of vehicle used in accordance with the formulation desired.

The recitations "detergent and conditioning cosmetic" in claim 1, and "for cleaning or removing make-up from keratinous substances, or for conditioning keratinous substances" in claim 44 have not been given patentable weight because the recitation occurs in a preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process step or structural limitations are able to stand alone. MPEP 2111.02.

It is noted that a composition and its properties are inseparable. *In re Papesch*, 315 F.2d 381, 391, 137 USPQ 43, 51 (CCPA 1963). Since '747 in view of '211 teach the same composition as instantly claimed, said composition will, obviously, be transparent.

Claims 33 and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over '747 and '211 as applied to claims 1-32, 34-41 and 43-47 above, and further in view of Naito et al. (USPN 5476649).

'747 and '211 apply as disclosed above. The references lack 18-methyl-eicosanoic acid and polyalkylene glycols.

Naito et al. teaches 18-methyl-eicosanoic acid as a branched fatty acid that imparts excellent conditioning effects to the hair and prevents the hair from being

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damaged (Abstract; col. 1, lines 54-67). Polyalkylene glycols are taught as hair care ingredients that impart moisturization and flexibility to the hair.

It would have been obvious to one of ordinary skill in the art at the time of the invention to add 18-methyl-eicosanoic acid and/or polyalkylene glycol, as taught by Naito et al., to the composition of '747 because (1) both '747 and Naito et al. are drawn to compositions for the improvement of hair styling and/or conditioning effects; and (2) '747 teaches that additional agents (e.g. moisturizers) may be added to the composition taught therein. One would have been motivated to combine the agents of Naito et al. to the composition of '747 because of the expectation of success in achieving a hair care product that additionally conditions the hair and prevents it from being damaged, and/or imparts moisturization and flexibility to the hair.

Response to Arguments

Applicant's arguments with respect to claims 1-47 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory W Mitchell whose telephone number is 571-272-2907. The examiner can normally be reached on M-F, 8:30 AM - 4:30 PM.

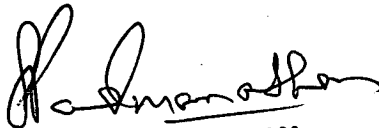
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 571-272-0629. The fax phone

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number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

gwm



SREENI PADMANABHAN
SUPERVISORY PATENT EXAMINER